



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/143,067	08/28/98	CHU	D 8736L-7396

LM02/0412

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WASHINGTON DC 20004

EXAMINER
BRITTON, H

ART UNIT	PAPER NUMBER
2713	

DATE MAILED: 04/12/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/143,067

Applicant(s)
Joung et al.

Examiner
Howard W. Britton

Group Art Unit
2713



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-34 _____ is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-34 _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/241,556

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The list of references to be printed in the reissue patent should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application. Therefore, applicants are required to submit all references of record in the patent on a form 1449 suitable for printing in the reissue.

2. The reissue oath/declaration filed with this application is defective because it fails to specifically identify the at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). *error 5-5-2005/B*

It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims

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with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479.

All reissue oaths or declarations must comply with 37 CFR 1.175(a)(5) by "particularly specifying the errors relied on, and how they arose or occurred". 37 CFR 1.175(a)(5) has two specific requirements, both of which must be complied with in the reissue oath or declaration. This section requires applicant to particularly specify (1) "the errors relied upon" and (2) "how they arose or occurred."

*error
5-5-2000*

It is particularly important that the reissue oath or declaration specify in detail how the errors arose or occurred. Included are inadvertent errors in conduct; i.e., actions taken by the applicant, the attorney, or others before the original patent issued, which actions are alleged to have caused the defect in the patent. "How" includes when and under what circumstances the errors arose or occurred. This means that the reissue oath or declaration must specify the manner in which "the errors" "arose or occurred" *Hewlett - Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 11 USPQ2d 1750 (Fed. Cir. 1989); *In re Weiler et al.*, 229 USPQ 673 (Fed. Cir. 1986). For example, the

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reissue oath or declaration must indicate when and the manner in which the reissue applicant became aware of the prior art or other information and of the error in the patent; such as, for example, through discovery of prior art or other information subsequent to issuance of patent, knowledge of prior art or other information before issuance of patent with significance being brought out after issuance by third party through allegations made in litigation involving the patent , etc. It is particularly important that the reissue oath or declaration adequately specify how the errors arose or occurred. If the reissue oath or declaration does not particularly specify "how," i.e., the manner in which the errors arose or occurred, the Office will be unable to adequately evaluate reissue applicant's statement in compliance with 37 CFR 1.175(a)(6) ^{error} that the "errors arose 'without any deceptive intention' on the part of the applicant"; see MPEP § 1414.04.

3. Claims 1-34 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

CROSBY	5,200,749
DORRICOTT	5,353,119.

5. Claims 1-34 are allowable over the art of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard W. Britton whose telephone number is (703) 305-4724. The examiner can normally be reached on Monday through Friday from 8:30 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley, can be reached on (703) 305-4856. The fax phone number for this Group is (703) 308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


HOWARD BRITTON
PRIMARY EXAMINER

April 7, 2000 hwb